

REMARKS

Claims 1-17 are currently pending in the subject patent application. Claims 10-13 and 15-17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Brenton and Stagnone (U.S. Patent No. 5,469,624) in view of Gauvry (U.S. Patent No. 4,742,617), since the Examiner asserted that Brenton and Stagnone discloses a pair of scissors comprising a first shaft (10) having a handle portion (14/16) and a cutting portion (12a) separated by a first pivot location; a circular thumb ringlet (18); and means (36) in the form of a flexible pin for rotatably connecting the thumb ringlet (18) to the first shaft (10). The Examiner also stated that Brenton and Stagnone's thumb ringlet is of a closed-loop type rather than an open loop. The Examiner then continued that scissors with an open loop thumb ringlet are well known in the art as evidenced by Fig. 1 of Gauvry, and concluded that in view of this fact, it would have been obvious to one skilled in the art at the time this invention was made to modify Brenton and Stagnone by providing the scissors with an open loop thumb ringlet (18), since the modification is obvious because it would only involve selecting one known type of thumb ringlet for another for a pair of scissors.

The Examiner noted that Brenton and Stagnone's flexible pin (36) is made of plastic material (see Col. 2, lines 6-8), but concluded that to select a well known plastic material such as thermoplastic polymers for Brenton and Stagnone's flexible pin would have been obvious to one having ordinary skill in the art, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

Applicant respectfully disagrees with the Examiner concerning this ground of rejection, since Brenton and Stagnone requires that the thumb ringlet be fully rotatable, flexible and interchangeable. See Col. 3, lines 4-7 of Brenton and Stagnone where it is stated that: "Ringlet 18 is rotatable attached to extension means 16. It is preferred that ringlets be constructed from flexible materials so that additional motion is available to an inserted thumb of the user of the device." Gauvry, by contrast in Col. 6, lines 3-12, states: "Thus, the present invention

provides a thumb loop 38 which is initially oriented in the pre-chosen natural position for most users but which is capable of slight movement to accommodate variously sized hands. Also the interconnection between thumb loop 30 and the second gripping means 28 is dampened and limited to the extent that full control of operation of the scissors is possible even with the configuration which allows initial flexibility of the thumb loop with respect to the scissors configuration.” (Emphasis added by Applicant.)

Therefore, the replacement of the thumb loop of Brenton and Stagnone with that described in Gauvry, as suggested by the Examiner, would clearly destroy the function of the invention of Brenton and Stagnone for its intended purpose. The design of the thumb loop of Gauvry and the manner in which it is secured to handle means 20, does not permit any of the required functionality of the thumb ringlets of Brenton and Stagnone, namely, full rotatability, flexibility and interchangeability. As a result, Applicant respectfully believes that the Examiner has improperly combined the Gauvry reference with Brenton and Stagnone and, therefore, has failed to make a *prima facie* case for obviousness under 35 U.S.C. 103(a) (“It is not *prima facie* obvious to modify a reference so as to destroy its intended function.” In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

Additionally, nowhere in Brenton and Stagnone or in Gauvry is it mentioned that the thumb ringlet is adjustable, as is required by the subject claimed invention. In fact, Brenton and Stagnone in Col. 3, lines 39-45, requires that “Once inserted into the hole, the deformable enlarged portion prevents the escape of the ringlets during use, and the extension arm may be cut off. If another ringlet is to be installed, the enlarged portion is simply cut off from the installed ringlet and that ringlet discarded.” That is, if the ringlet of Brenton and Stagnone is to be enlarged or made smaller, it is replaced by a ringlet of suitable size. Thus, Brenton and Stagnone teaches away from the present claimed invention. This clear departure of the invention of Brenton and Stagnone from the present claimed invention is not corrected by Gauvry which reference suggests a cementing process in addition to a mechanical attachment of the post which supports thumb loop 30. Thus, Brenton and Stagnone and Gauvry teach away from each other, and the combination, if

made as suggested by the Examiner, teaches away from the present claimed invention. Applicant therefore believes that the Examiner has improperly combined Brenton and Stagnone with Gauvry, and thus has failed to make a *prima facie* case for obviousness under 35 U.S.C. 103(a).

Since Applicant respectfully believes Brenton and Stagnone have been improperly combined with Gauvry by the Examiner, the combinations of these references with Mock and Pracht as suggested by the Examiner are likewise improper, and Applicant believes that no further response is required for these grounds of rejection.

The Examiner objected to claim 5 as being dependent upon a rejected base claim, but would allow this claim if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In view of the arguments presented hereinabove, applicant believes that subject claims 1-17 are in condition for allowance or appeal, the former action by the Examiner at an early date being earnestly solicited.

Reexamination and reconsideration are respectfully requested.

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Respectfully submitted,

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